



In the Response filed July 15, 2005, Applicants elected Invention I (as defined by the Examiner) **with traverse** and presented reasons for traversal. In the Office Action dated September 20, 2005, the Examiner acknowledged Applicants' timely traversal; however, the Examiner made the restriction requirement final. Applicants hereby petition for withdrawal of the restriction requirement for at least the following reasons.

In the Office Action dated June 27, 2005, the Examiner contends that Inventions I and II "are related as subcombinations disclosed as usable together in a single combination." However, Inventions I and II are not *disclosed as subcombinations* usable together *in a single combination*. For example, embodiments of the method of claim 18 (Invention I) can be carried out on embodiments of the system of claim 36 (Invention II). Embodiments of claims 18 and 36 are clearly not described in Applicants' disclosure as separate subcombinations usable together in a single combination. Similarly, claim 51 (group I) and claim 36 (group II) both recite similar systems, not separate subcombinations usable together in a single combination. As described in Applicants' disclosure, the adapter recited in claims 36 and 62 is one example of the various means recited in claim 51. Claim 51 and claims 36/62 clearly cannot be characterized as being restricted to separate subcombinations. Although claims 1, 18, 51 and 73 may certainly vary in scope from claims 36 and 62, the Examiner has clearly mischaracterized Applicants' claims as requiring separate subcombinations usable together in a single combination. Thus, the restriction requirement is improper. A difference in terminology or scope between claims does not mean that the claims are limited to separate subcombinations.

A proper restriction requirement under M.P.E.P. 806.05(d) requires that the subcombinations "do not overlap in scope". As discussed above, there is clearly overlap in scope between the claims of group I and the claims of group II. Applicants are by no means asserting that the scope of the claims of group I is identical to the scope of the claims of group II. In fact there are clearly differences in scope between the claims. However, some of the claims of group I do have some overlap in scope with some of the claims of group II. For example, from even the most cursory glance, it is readily

apparent that claim 51 (group I) and claim 36 (group II) both recite similar systems overlapping in scope, not separate subcombinations. Since, claims of group I have some overlap in scope with claims of group II, restriction cannot be required under M.P.E.P. 806.05(d). Therefore, the Examiner's restriction requirement is improper.

Furthermore, according to M.P.E.P. 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, "[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, M.P.E.P. 806.05(d) also states that "the burden is on the Examiner" to make this showing. The example given by the Examiner is that invention II has separate utility of "interfacing to external systems containing different type [sic] of database objects." However, all of the independent claims in both groups read on embodiments as described in Applicants' disclosure that may interface to external systems which may contain different types of objects. Thus, the Examiner clearly has not shown a separate utility for one of the subcombinations other than in the disclosed combination.

On p. 3 of the Office Action of September 20, 2005, the Examiner states: "Although both groups may have same utility in interfacing to external systems, their focuses are rather different." However, merely having differences in focus does not meet the specific criteria required to establish a proper requirement for restriction. In fact, by stating that "both groups may have same utility in interfacing to external systems", the Examiner appears to have admitted that she has failed to establish a separate utility. Thus, by the Examiner's own admission, a *prima facie* requirement for restriction has not been stated.

The Examiner also attempts to justify the restriction requirement by stating on p. 3 of the Office Action of September 20, 2005 that "groups I and II are classified in two very different classes: [7]19 and 707, respectively." However, simply being classified in two different classes does not satisfy the requirements of M.P.E.P. 806.05 to establish a

proper restriction requirement. Furthermore, the Examiner's classification is not accurate, as discussed in more detail below.

On p. 4 of the Office Action of September 20, 2005, the Examiner states: "A major difference between claims 36 and 51 is that the former **configures an adapter to perform the three functions** associated with the receiving (or receive), mapping (or map) and driving (or drive) steps, as opposed to straightforwardly implementing the functions as three separate means." First of all, Applicants fail to see what point the Examiner is trying to make with this statement since the Examiner's comparison of claims 36 and 51 fails to address any of the flaws in the Examiner's restriction requirement, such as the Examiner's failure to provide an example of a separate utility for one of the subcombinations other than in the disclosed combination. Furthermore, the Examiner has mischaracterized the claims. Contrary to the Examiner's assertion, claim 36 does not recite anything that "configures an adapter". Instead, claim 36 simply recites "an adapter configured to: receive ...; map ...; and drive ...." Claim 51 recites "means for receiving ...; means for mapping ...; and means for driving ...." Neither the claims nor Applicants' disclosure requires a separate implementation of the three means recited in claim 51. In fact, upon even the most cursory reading of Applicants' disclosure, anyone of ordinary skill in the art would understand that the adapter recited in claim 36 is one example of the three means recited in claim 51. Thus, the Examiner's comparison of claims 36 and 51 is both inaccurate and fails to establish any of the necessary elements of a proper restriction requirement.

On p. 4 of the Office Action of September 20, 2005, the Examiner also refers to the first three paragraphs of the SUMMARY OF THE INVENTION section of Applicants' disclosure. However, nothing in this portion of Applicants' disclosure states a separate utility for either of the claim groups defined by the Examiner. Furthermore, the description of the adapter in the second and third paragraphs could apply to embodiments of either claim 36 or claim 51. The Examiner's reference to this portion of Applicants' disclosure does not in any way establish a proper restriction requirement.

The Examiner has clearly failed to meet the required burden to establish a separate utility. Applicants have provided reasons showing that the example of a separate utility suggested by the Examiner is not actually separate. The facts in support of Applicants' argument are that nothing in Applicants' disclosure or claims precludes the utility suggested by the Examiner from being practiced for both Invention I and Invention II. A further fact in support of Applicants' argument is that the Examiner herself admitted on p. 3 of the Office Action of September 20, 2005 that the suggested utility is not a separate utility by admitting that "both groups I and II may have same utility in interfacing to external systems." Thus, the utility suggested by the Examiner is clearly not a separate utility. The Examiner has clearly failed to meet the requirement of M.P.E.P. § 806.05(d) to "document a viable separate utility". Therefore, the restriction requirement between Inventions I and II must be withdrawn.

Finally, on p. 4 of the Office Action of September 20, 2005, the Examiner states that "although groups I and II are related inventions (i.e., related as sub-combinations of one another), they are nevertheless distinctive under the criteria of MPEP § 806.05(c) - § 806.05(i) (see MPEP 808.02)." First of all, "sub-combinations of one another" is not a valid category of related inventions for which restriction may be required. Applicants assume the Examiner meant to say "subcombinations disclosed as usable together in a single combination" since that is how the Examiner characterized Inventions I and II in the Office Action of June 27, 2005. Furthermore, as shown above, the Examiner has clearly failed to meet the requirements of MPEP § 806.05(d) to establish a proper restriction requirement for subcombinations disclosed as usable together in a single combination. As shown above, the claims as grouped by the Examiner are not limited to subcombinations that do not overlap in scope and are disclosed as usable together in a single combination, and the Examiner has failed to show a truly separate utility. Nor has the Examiner met the requirements of any of the other sections of MPEP § 806.05(c) - § 806.05(i) to establish a proper restriction requirement.

Another shortcoming of the Examiner's restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show "reasons why there would

be a serious burden on the examiner if restriction is not required”. In regard to this requirement, the Examiner stated in the Office Action of June 27, 2005 that the inventions “have acquired a separate status in the art as shown by their different classification.” However, the Examiner’s reliance of a different classification to show a separate status in the art is misplaced because the purported classifications are clearly inaccurate and not separate for the two claim groups. For example, the Examiner states that Invention I is classified as class 719, subclass 315 and that Invention II is classified as class 707, subclass 101. However, these classifications could both be applied to all of the claims, and are thus not separate for the two groups. According to the Manual of Classification, the definition of class 719, subclass 315 is for interprogram communication using object oriented message. However, neither the claims of group I nor the claims of group II require “interprogram communication using object oriented messaging”. Nor do they exclude such messaging. Thus, class 719, subclass 315 is not a truly separate classification for the claims of groups I and II.

The definition for class 707, subclass 101 is for manipulating data structure (e.g., compression, compaction, compilation). However, the claims of group II do not require or exclude any sort of compression, compaction or compilation of a data structure. The classification of group II as class 707, subclass 101 is not a very accurate classification. Furthermore, none of the claims either require or exclude any sort of compression, compaction or compilation of a data structure.

As shown above, under an accurate classification, the Examiner has not established that separate classifications apply to the claim groups. Since the purported classifications are not very accurate and actually relate to all of the claims, the Examiner clearly cannot rely upon these flawed classifications to establish “a serious burden on the examiner if restriction is not required.” See M.P.E.P. § 808. Since the Examiner’s has failed to establish a “serious burden on the examiner if restriction is not required”, Applicants’ assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner’s restriction requirement must be withdrawn.

## CONCLUSION

In light of the above remarks, Applicants request that the restriction requirement be withdrawn.

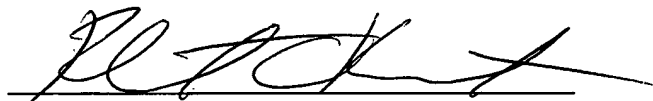
If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-52901/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Other:

Respectfully submitted,

  
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